

REMARKS

With regard to the Examiner's comments on page 2 of the Office Action mailed October 24, 2006, applicants acknowledge that the subject matter of the various claims in the present application was commonly owned at the time any inventions covered therein were made.

Claims 1-2 and 5-21 are rejected under 35 USC 103(a) as being unpatentable over Kiel et al. (US 2003/0077321) in view of Chopdekar et al. (US 5,663,415).

With regard to Kiel et al., applicants would like to point out that the present application was filed *March 22, 2004*, and claims priority to a provisional application filed *March 25, 2003*. U.S. Patent App. Pub. No. US 2003/0077321 to Kiel et al. (the "321 publication") was published *April 24, 2003*. Since the '321 publication was published after applicants' provisional application was filed and less than one year from the date of the non-provisional filing, it is not prior art under 35 U.S.C. 103(a). Moreover, since the inventors of the '321 publication and the present application are identical, the '321 publication was not described in a published application by "another," and 35 USC 102(e) is inapplicable.

To refresh the Examiner's recollection, applicants submit herewith as Appendix A, a copy of applicants' Response mailed February 23, 2006 in response to the Non-final Office Action mailed September 26, 2005 wherein the Examiner rejected claims 1-2 and 5-21 of the present application under U.S.C. 102(b) and 103(a) based on Kiel et al. in view of Chopdekar et al. (US Pat.No. 5,663,415). Again, to refresh the Examiner's recollection, the Examiner acknowledged that Kiel et al. was not prior art by withdrawing the rejection based on Kiel et al. and issuing another Non-final Office Action based on Chen et al. (US Pat. No. 6,383,471) and Chopdekar et al. (US Pat. No. 5,663,415).

With regard to Chopdekar et al., as the Examiner indicates, the reference discloses a process of preparing antihistamine tannates. Gabapentin is not an antihistamine and is not disclosed, taught or suggested in Chopdekar et al. See applicants' "Remarks" mailed May 16, 2006, page 3, line 15 – page 4, line 6.

As discussed above, Kiel et al. is not prior art under 35 U.S.C. 103 (a) and cannot be combined with Chopdekar et al. to render pending claims 1-2 and 5-21 as being unpatentable under 35 U.S.C. 103(a).

It is confusing that the Examiner continues to rely on Chen et al. in the present rejection (See page 5, first two paragraphs) when Chen et al. is no longer cited as a prior art reference. Applicants successfully distinguished Chen et al. in their Response filed August 10, 2006.

Applicants assert that it has been successfully established that:

- 1) Kiel et al. is not prior art under 35 U.S.C. 102 (b), 102 (e) or 103 (a); and
- 2) Chen et al. erroneously included gabapentin as a hydrophobic therapeutic agent when gabapentin is, in fact, hydrophilic.

The Examiner cannot rely on Chopdekar et al., alone, to reject claims 1-2 and 5-21 because Chopdekar et al. never mentions gabapentin or gabapentin tannate or a process for preparing same.

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Based on the above, applicants respectfully submit that claims 1-2 and 5-21 are in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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APPENDIX A